United States Court of Appeals

for the

District of Columbia Circuit

TRANSCRIPT OF RECORD

IN THE

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA.

APRIL TERM, 1939.

518

No. 7476.

Edward S. Levine

~~CARTER CARBURETOR CORPORATION, a Corporation of the State of Delaware~~, *Appellant*,

v.

CONWAY P. COE, Commissioner of Patents.

BRIEF FOR APPELLANT.

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CARTER CARBURETOR CORPORATION, a Corporation of the State of Delaware, *Appellant*,

v.

CONWAY P. COE, Commissioner of Patents.

BRIEF FOR APPELLANT.

This is an appeal from the judgment of the United States District Court for the District of Columbia (Bailey, J.) dismissing appellant's bill of complaint filed in accordance with the provisions of R. S. §4915, as amended (35 U. S. C. §63), to compel the issuance of a patent upon an application of Otto Henning, Serial No. 575,577, of which appellant[1] is the assignee. Appellee is the Commissioner of Patents of the United States.

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[1] Herein the appellant, Carter Carburetor Corporation, will be referred to as plaintiff and appellee, Conway P. Coe, Commissioner of Patents, will be referred to as defendant.

JURISDICTIONAL STATEMENT.

(a) The statutory provision believed to sustain the jurisdiction of the District Court is R. S. §4915; c. 74, §9, 27 Stat. 436; §63, Tit. 35, U. S. C.

The statutory provision believed to sustain the jurisdiction of this Court upon the appeal is § 226 of the Code of Law for the District of Columbia, c. 854, 31 Stat. 1189, as amended.

(b Final action of the Patent Office denying plaintiff the right to ~~make~~ the claims in issue was taken on November 2, 1936 (R. 266). The present suit was instituted on March 31, 1937 (R. 1). The jurisdiction of the District Court under R. S. § 4915 and the facts upon which the jurisdiction is predicated (R. 3, 6, 7) are admitted by the answer (R. 11, 12).

The final judgment of the Court below is dated May 23, 1939 (R. 130). Notice of appeal was filed June 16, 1939 (R. 135). Rule 73(a), Federal Rules of Civil Procedure; Rule 10 (1); 35 (1), Rules of the United States Court of Appeals for the District of Columbia.

STATEMENT OF THE CASE.

Plaintiff in this proceeding seeks a decree adjudging that it is entitled, according to law, to receive a patent for the invention specified in Claims 20, 21, 22, 25 and 26 of the Henning application, and authorizing the Commissioner of Patents to issue it a patent containing those claims. (R. 7)

The Henning application is for an improvement in Internal Combustion Engines (R. 139 *et seq.*). It was filed in the United States Patent Office on November 17, 1931 (R. 141), having theretofore been assigned in its entirety to plaintiff by an instrument in writing dated October 31, 1931 and recorded on November 17, 1931 (R. 4, 12).

Claims 20, 21, 22, 25 and 26 here in issue were not included in the Henning application as filed, but were inserted therein by amendment filed on December 9, 1935. (R. 189, 190-192) Claims 20, 21 and 22 correspond to Claims 36, 37 and 38 of Patent No. 1,945,191 to Scott F. Hunt, which was filed on May 4, 1931 and issued January 30, 1934, and were copied therefrom in the amendment of December 9, 1935 of the Henning application.[2] (R. 127)

The Examiner accordingly set up the Hunt Patent No. 1,945,191 as an antipication of the claims (R. 207) and that patent is the sole reference which has been cited or relied upon by the Patent Office, either in the Office proceedings or in the Court below, to defeat plaintiff's right to ~~make~~ the claims. (R. 6, 7, 12)

Claims 20, 21 and 22 read as follows (R. 10):

> "20. In combination with an internal combustion engine, a carburetor having a throttle and a pressure responsive choke valve, temperature responsive means yieldingly urging the valve toward closed position and rendered inoperative at high temperatures, and means responsive to suction posterior to the throttle for moving the valve to a partially opened position against the force of the temperature responsive means.
>
> "21. In combination with an internal combustion engine, a carburetor having a choke valve, temperature responsive means yieldingly urging the valve toward closed position at low temperatures, additional means resisting opening movement of the valve, said suction operated means

---

[2] Claims 25 and 26, though not contained in the Hunt Patent, are, nevertheless, similar to Hunt Claims 36, 37 and 38 and plaintiff concedes that the disposition of Claims 20, 21 and 22 will be determinative of its right with respect to Claims 25 and 26. (R. 14, 15)

> operative to render said additional means inoperative and to move the valve to at least partially opened position against the force of the temperature responsive means.
>
> "22. In combination with an internal combustion engine, a carburetor having a throttle and a pressure responsive choke valve, means operative below a predetermined temperature to yieldingly urge the valve toward closed position, additional means resisting opening movement of the valve, and means responsive to a predetermined suction posterior to the throttle for rendering said additional means inoperative and for moving the valve to at least partially opened position against the force of the temperature responsive means."

The Claims thus specify and require a choke valve mechanism in combination with a carburetor for internal combustion engines, which employs the following means to perform the following specific functions:

(1) temperature responsive means *yieldingly urging the valve toward closed position*, and

(2) *rendered inoperative at high temperatures*, and

(3) means responsive to suction posterior to the throttle *for moving the valve to a partially opened position*

(4) *against the force of the temperature responsive means.*

A device exactly responding to each of the foregoing limitations of the Claims in issue is illustrated in Fig. 1a of the Henning drawings (R. 167) which the defendant concedes to have been fully described and shown in the Henning application as filed (R. 21-22).

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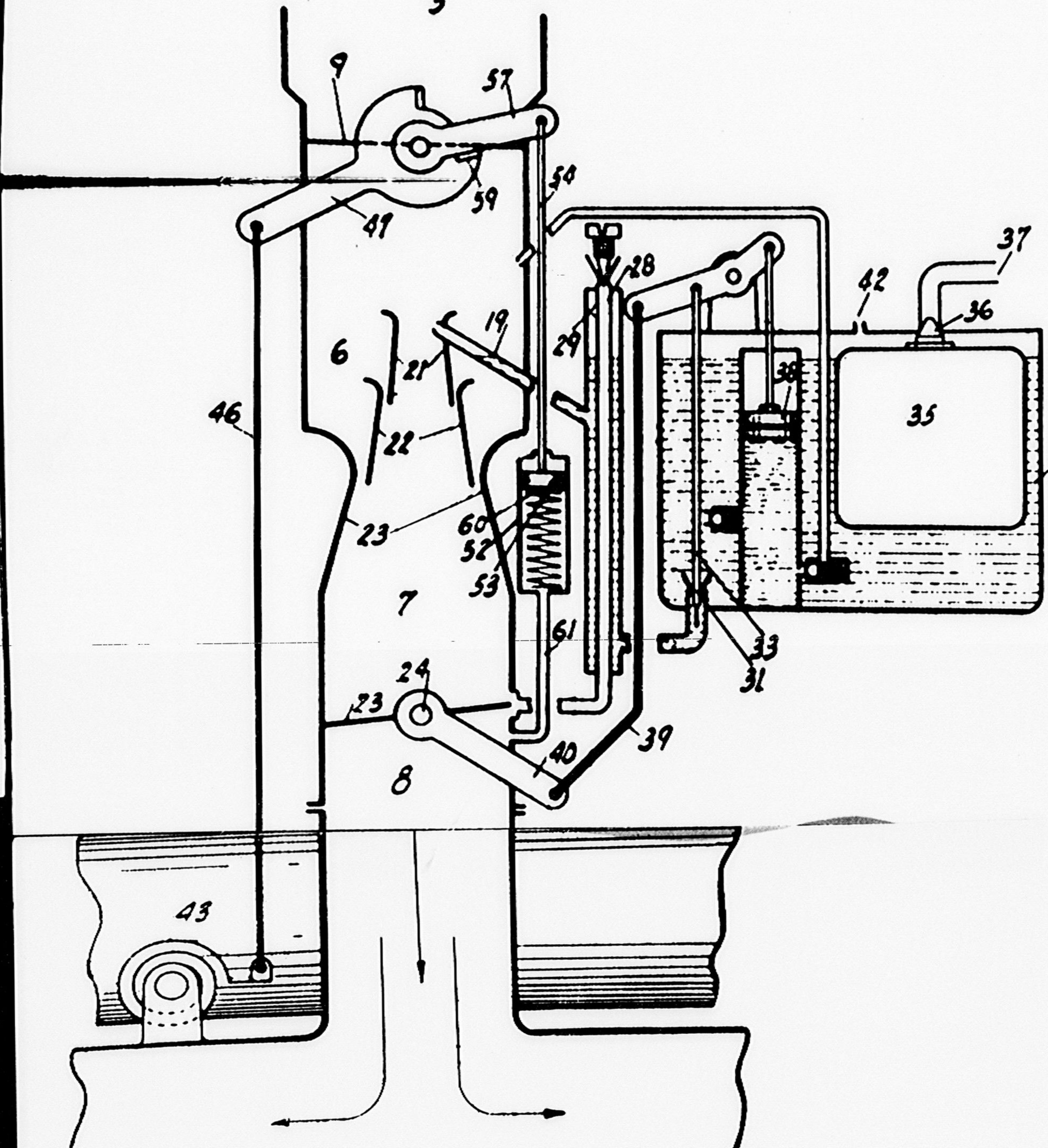
FIG. 1a



OTTO HENNING
INVENTOR

BY

ATTORNEY

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In this embodiment, which is reproduced on the opposite page, the choke valve 9 is connected by means of lever 47, which is rigidly mounted on the choke valve shaft, and rod 46, to temperature responsive means 43, and by means of lever 57, which is revolvably mounted on the choke valve shaft, through rod 54, to piston 53, which is in turn connected to spring 60 and by means of conduit 61 to a point posterior to the throttle 23. (R. 145-146)

Applied to the specific limitations of the Claims in issue, the operation of the device thus illustrated may be described as follows:

Below a predetermined temperature and prior to the starting of the engine, the temperature responsive means 43 exerts a downward force upon rod 46 which, communicated through lever 47 to the choke valve shaft, operates to hold the choke valve 9 in closed position. As soon as the engine begins to fire, the suction existing in the manifold intake 8 posterior to the throttle 23, operates, through conduit 61, to exert a downward pull upon the piston 53 which by means of rod 54, lever 57 and projection 59 is communicated to the choke valve 9 which is thereby moved to at least a partially opened position against the force of the temperature responsive means 43. Thereafter, as the engine warms up, the temperature responsive means 43 responds in accordance with the temperature existing in the exhaust manifold, to which it is connected, by expanding in a counter-clockwise direction, until, at high temperatures, the choke valve is moved to fully opened position, whereupon the temperature responsive means 43 ceases to have any effect upon the action of the valve. (R. 147-148)

The Hunt Patent No. 1,945,191 discloses three separate embodiments or modifications of his invention. These are illustrated in Figures 1 to 5 inclusive, Figure 6 and Figure 7 respectively in the drawings of the Hunt patent. (R. 339, 340) Admittedly, neither the embodiment illustrated in Figures 1 to 5 inclusive nor the embodiment illustrated in Figure 6 of the Hunt Patent nor the specification with reference thereto, contains any disclosure of "means responsive to suction posterior to the throttle for moving the valve to a partially opened position against the force of the temperature responsive means," and the embodiment of Figure 7 of the Hunt patent alone is relied upon by the defendant to support Hunt's disclosure of the claims in issue (R. 244, 260, 284).

As illustrated in Hunt's original application, Figure 7 was drawn in the following form (R. 314):

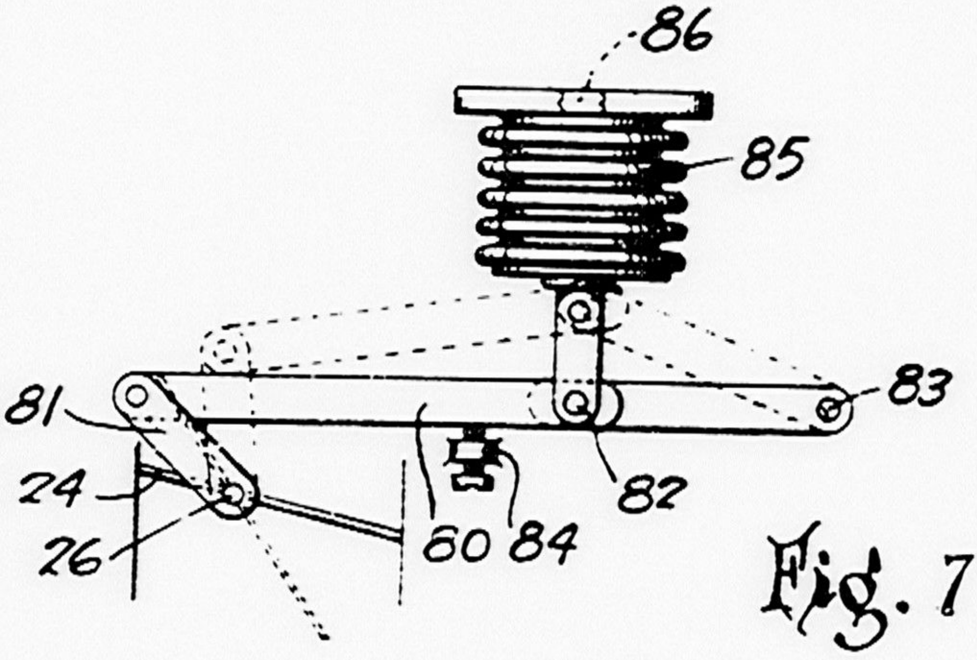

Fig. 7

With respect to that form of the device, the specification stated (R. 305):

> "In the form of the invention shown in Figure 7, the thermostat has not been illustrated but if preferred, the thermostat shown in Figure 6[3] may be incorporated, and the modification consists in the substitution of a vacuum controlled toggle joint for the piston or bellows shown in the other constructions."

By an amendment filed on February 10, 1933, the words "thermostat has not been illustrated, but if preferred, the thermostat shown in Figure 3 may be incorporated, and the" in the foregoing quotation were stricken out and there was added to the description of the device shown in Figure 7, the statement: "The thermostat mechanism is the same as that described in connection with Figure 3." (R. 326) At the same time, the drawing of Figure 7 was modified, as set forth below, to show the thermostatic connection of Figure 3 referred to in the amended specification (R. 331):

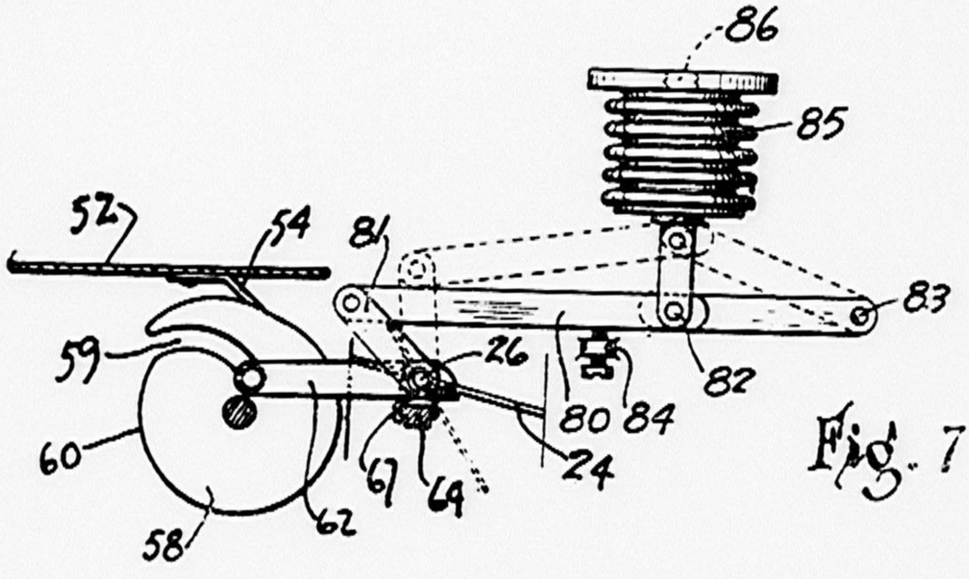

Fig. 7

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[3] By an amendment filed on February 9, 1933, the Figure "6" was changed to "3". (R. 323)

And by the same amendment, dated February 9, 1933, and filed on February 10, 1933, there were inserted in the Hunt application *for the first time* the claims 36, 37 and 38, corresponding to Claims 20, 21 and 22 in issue (R. 327-328)

With respect to the operation of the device as shown in Figures 1 to 5 inclusive, the specification of the Hunt patent states (R. 306-307):

> "In the operation of the invention with particular reference to the forms shown in Figures 1 to 5, inclusive, the initial start of the engine is ordinarily made with a cold thermostat and with the choke valve in the position shown in full lines in Figure 2. * * *
>
> "The vacuum developed by the cranking operation is insufficient to lift piston 40 against the resistance of spring 44 and valve 24 is substantially locked in its closed position by the pressure of pin 47 within the notch 48. As soon as the engine starts, the vacuum above the throttle is increased and a piston 40 is moved upwardly and removes the pressure upon pin 47. *Thereupon, valve 24 may be moved by air flow in a clockwise direction against the tension of spring 67* until bracket 64 has the outer portion of its side face in contact with lever 62, which movement is preferably not over 10 or 15 degrees. After the engine is started, the hot gases in exhaust pipe 53 transmit heat to the thermostat 54 which rotates cam 58 in a clockwise direction as viewed in Figure 3, and moves the end of lever 62 to the outer portion of slot 59. This movement of lever 62 rotates valve 24 in a clockwise position until the valve reaches the position shown in dotted lines in Figure 2. At this point in the valve movement, lever 62 emerges from slot 59 and further rotation of the cam 58 under the influence of increased heat, permits the cam to freely rotate with the end of lever 62 in

> sliding contact with the concentric portion 60 of the cam without further movement of the choke valve."

And with specific reference to Figure 7, the specification states (R. 307):

> "In the operation of the forms shown in Figures * * * 7, *a similar result will be obtained*, although in * * * Figure 7, the resistance is obtained by the straight line position of the toggle."

In the Patent Office proceedings, plaintiff took the position, which is the basis of its contentions in the present case, that Claims 36, 37 and 38 of the Hunt patent, having been inserted in the application therefor nearly 15 months after the Henning application disclosing the invention of those claims was filed, could not be considered *per se* prior art against the Henning claims but at most served merely to raise a *prima facie* and rebuttable presumption that the claims were supported in the original disclosure; that the presumption of validity attending the issuance of the patent could give the amendment no greater effect; that such presumption being rebuttable might be overcome by evidence showing an absence of foundation in the original disclosure for the claims, and that the entire absence of any such foundation was clearly manifest in the instant case. (R. 250-259; 274-281) Plaintiff therefore asked the Examiner to declare an interference between Claims 20, 21 and 22 of the Henning application and Claims 36, 37 and 38 of the Hunt patent (R. 206) This request was denied on the ground that Henning had failed to make the oath of priority of invention required by Patent Office Rule 94 which, by reason of Hunt's earlier filing date, he was unable to make (R. 244).

Both the Examiner and the Board of Appeals admitted that the device of Figure 7 is inoperative as shown (R. 244, 261), but held that such inoperativeness might be overcome by modifications involving no more than the ordinary skill of the art and that when so modified the device might respond to the limitations of the claims (R. 207-8; 261, 266). Allowance of the claims to plaintiff was accordingly denied (R. 267).

In so holding the tribunals of the Patent Office apparently ignored the obvious facts pointed out by plaintiff (R. 250-259; 274-281) that the sole function of the toggle joint and bellows mechanism described in Figure 7 of the Hunt Patent is to provide an additional force against opening of the choke during the cranking operation, which Hunt's thermostat alone is unable to supply; that the toggle and bellows merely take the place, in the device of Figure 7, of the piston operated latch to accomplish the same purpose in the other modifications of Hunt's invention; that in none of these modifications does the suction responsive means move or even tend to move the choke valve to a partially opened position *against the force of the temperature responsive means;* and that a modification of the device of Figure 7 to enable it to perform that function, even if possible, would be so radical a departure from any teaching or disclosure of the patent as itself to constitute invention.

To none of these objections did either of the tribunals of the Patent Offive give any answer, save that a mechanic confronted with the necessity of modifying Figure 7 to meet the limitations of Claims 36, 37 and 38 might find in *those claims* a sufficient descripto to enable him to produce the desired result.

Thus, the Examiner, in Paper #24 of the Henning file wrapper, (R. 207), stated:

> "Claims 19 to 22, which are claims 35 to 38 of the Hunt patent, are rejected as fully met by said patent. Applicant, not having sworn back of the Hunt patent on the subject-matter of these claims, is not entitled to interference proceedings therewith under the provisions of Rule 94. Applicant has argued that these claims are not supported by Hunt's disclosure, but the examiner finds that they read on the embodiment shown in Fig. 7 of the patent if we allow for certain draftsman's errors readily corrected by one normally skilled in the art after reading the specification and *claims*. Even if errors in the drawing were not readily allowed for, *the claims themselves* would constitute ample disclosure to bar the issue of a patent to applicant upon that subject-matter." (Italics supplied)

But inasmuch as the very question raised is whether *those claims* have any proper basis in the patent, such reasoning is manifestly unsound.

In the Court below, plaintiff again renewed its objections to Figure 7 as an anticipation of the claims in issue and in support thereof adduced evidence, including the testimony of Hunt himself, to show:

(1) That Hunt did not, prior to the amendment of February 10, 193~~5~~3 of his application, conceive a device capable of performing the functions called for by the claims in issue.

(2) That in all of Hunt's prior research and in the device commercialized by his assignee, Bendix Products Corporation, the automatic choke mechanism em-

ployed was a combination of a weak thermostat and a latching device, the purpose and effect of which were to hold the choke valve in closed position during the cranking operation and immediately thereafter to permit the choke valve to be moved to a partially opened position by the mere force of the air entering the carburetor through the choke valve passage in response to the suction developed by the engine, and not to move the choke valve toward a partially opened position against the force of the thermostat.

(3) That the inoperativeness of the device of Figure 7 may be cured, by the application thereto of the non-inventive skill of the art, to produce a device which will respond to the specification of the Hunt patent, but that any modification so made neither would nor could function in such a way as to satisfy the specific limitations of the claims in issue.

Again, as in the Patent Office proceedings, the defendant relied exclusively upon the Hunt patent and file wrapper to support the action of the Patent Office. No witnesses were produced at the hearing on behalf of defendant and, indeed, counsel for the defendant did not even cross-examine several of the plaintiff's witnesses.

In a memorandum opinion announcing its decision (R. 127) the District Court held merely that:

> "The decision of this case depends largely upon the question whether the amendment to the Hunt claims embraced matter not disclosed in his original application. I think that the change in the form of the thermostat shown in his Fig. 7, it having been stated in the specification that the thermostat shown in Fig. 6 could be used in con-

> nection with the device shown in Fig. 7, was not open to that objection.[4]
>
> "I am not satisfied, either, that the device shown in Fig. 7 with such modifications as a skilled mechanic might make, would be inoperative."

Thereafter, the District Court filed its findings of fact and conclusions of law (R. 127-131) adopting therefor the proposed findings and conclusions of the defendant in their entirety, and entered its judgment dismissing the bill of complaint (R. 130).

Such findings and conclusions wholly disregard the method of operation of Figures 1 to 5, Figure 6 and Figure 7 of the Hunt patent as explicitly set forth and disclosed in the specification thereof, which is at complete variance with the operation of the device called for by the claims in issue. Such findings and conclusions further overlook the facts as testified to by the patentee, Hunt, and evidenced by the documentary exhibits identified by him, that in none of the devices constructed by Hunt in the course of his development of the invention of the Hunt patent or even in the commercial embodiment thereof was the automatic choke valve mechanism of such a nature as would be capable of performing the functions called for by the claims in issue. Such findings and conclusions further ignore the uncontradicted testimony of plaintiff's expert witnesses, based upon their exhaustive efforts to overcome the inoperativeness of Figure 7, that any such device so modified as to be operative in accordance with the specification relative thereto, would be wholly incapable of satisfying the limitations of the claims in issue.

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[4] Plaintiff did not in the Court below and does not now contend that the changes in the drawing and specification with respect to Figure 7, effected by the amendment filed on February 10, 1933, were improper or *per se* introduced new matter into the Hunt application. What plaintiff does contend is that, conceding to Figure 7 the full benefit of the amended specification and description of the Hunt patent, it still does not disclose or support the invention designated by the added claims 36, 37 and 38. That question was not touched upon either in the opinion or findings of the Court below. It is therefore believed that the Court below failed to pass upon the basic issue in the case.

Accordingly, plaitiff, filed its motion, as authorized by Rule 52 (b) of the Federal Rules of Civil Procedure, for additional findings and amendment of the judgment in conformity therewith (R. 131)[5]. Such motion was granted by the Court only to the extent of finding that Claims 35, 36, 37 and 38 of the Hunt patent were aded to Hunt's application by amendment filed on February 10, 1933, and allowed June 16, 1933, and that on February 10, 1933, Hunt amended his application and drawings as set forth in the original findings of fact numbered 8 and 9 (R. 134). Plaintiff thereupon on June 16, 1939 filed notice of appeal (R. 135).

STATEMENT OF POINTS.

The points upon which appellant intends to rely on the appeal are:

(1) That the Court below erred in holding that the modifications necessary to make the device shown in Figure 7 of the Hunt patent operative are only such as a skilled mechanic would make, without also holding that such modifications would not and could not result in a device which would be capable of performing the specific functions required by the claims in issue.

(2) That the Court below erred in failing to find that even if the device as shown in Figure 7 of the

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[5] *Interstate Circuit* v. *U. S.*, 304 U. S. 55.

Hunt patent be considered as having been invented by Hunt prior to Henning's filing date of November 17, 1931 and even if it be made operable in accordance with the specification and disclosure of the Hunt patent, it contains no means for moving the valve 24 against the force of the temperature responsive means 54.

(3) That the Court below erred in failing to find that in the device shown in Figure 7 of the Hunt patent, the temperature responsive means 54 does not hold the choke valve 24 in closed position at any time, but that its function is, and must be, completed before the valve is closed.

(4) That the Court below erred in failing to find and hold that the device called for by the claims in issue differs in structure, function and mode of operation from the device of Figure 7 of the Hunt patent.

(5) That the Court below erred in failing to find and hold that if Figure 7 of the Hunt patent disclosed an accurate device operative in exact accordance with the specification and teachings of the Hunt patent, such device would be wholly incapable of performing the functions called for by the specific limitations of the claims in issue.

(6) That the Court below erred in failing to find and hold that the device of Figure 7 of the Hunt patent is not entitled, merely by reason of the fact that it is inoperative on its face, to be given a more favorable construction than it would have if that figure disclosed a device operative in exact accordance with the specification and teachings of the Hunt patent.

(7) That the Court below erred in holding that claims 20, 21 and 22 in suit read directly upon Figure 7 of the Hunt patent, and that claims 25 and 26 are not patentable over the disclosure of Figure 7 of the Hunt patent.

(8) That the Court below erred in holding that claims 20, 21, 22, 25 and 26 are not patentable in the Henning application.

(9) That the Court below erred in holding that plaintiff is not entitled to a patent on the Henning application containing claims 20, 21, 22, 25 and 26.

(10) That the Court below erred in dismissing the bill of complaint.

(11) That the Court below erred in failing to grant plaintiff the relief prayed for in the bill of complaint.

SUMMARY OF ARGUMENT.

I.

The Claims in Issue are not Anticipated by Hunt Patent No. 1,945,191.

A. Figure 7 of the Hunt patent alone is relied upon as an earlier disclosure of the claims in issue.

B. Figure 7 of the Hunt patent is inoperative on its face.

C. The inoperativeness of Figure 7 of the Hunt patent may be cured, but any modification thereof made in conformity with the specification and teaching of the Hunt patent would not produce a device capable of performing the several functions called for by the specific limitations of the claims in issue. Any modification of the device of Figure 7, which would enable it to satisfy the limitations of the claims in suit, would be antithetical to the specification, disclosure and teaching of the Hunt patent and would require invention.

D. Claims 36, 37 and 38 of the Hunt patent which were inserted therein by amendment of February 10, 1933, constituted new matter in the Hunt application, and such claims are invalid in view of the prior disclosure on November 17, 1931, in the Henning application, of the invention covered by those claims.

E. Conclusion: Henning is the first inventor of the invention covered by Claims 20, 21 and 22 in issue, and is entitled to a patent therefor. The decree of the District Court should therefore be reversed with directions to enter a decree in conformity with the prayers of the bill of complaint.

ARGUMENT.

I.

The Claims in Issue are not Anticipated by Hunt Patent No. 1,945,191.

I-A.

Figure 7 of the Hunt patent alone is relied upon as an earlier disclosure of the claims in issue.

The ultimate question in this case is whether the claims in issue are anticipated by Claims 36, 37 and 38 of the Hunt Patent No. 1,945,191, from which Claims 20, 21 and 22 in suit were copied. Intermediately, the question is presented as to whether Claims 36, 37 and 38 of the Hunt patent constitute new matter in view of the fact that those claims were first inserted in the Hunt application nearly 15 months after the Henning application, admittedly disclosing the invention of those claims, was filed.[6] The basic question therefore and the question upon which the validity of Hunt Claims 36, 37 and 38 as an anticipation of the Henning claims in suit depends, is whether the invention covered by those claims was present in and disclosed by the Hunt application at any time prior to Henning's filing date.[7]

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[6] In his opening statement, Mr. Whitehead, solicitor for the Commissioner, said:

> "May I say right here that the Patent Office has raised no objection to the disclosure of Henning as supporting these claims. * * * so far as the rejection is concerned, it is admitted that Henning discloses what he says he discloses, * * *." (R. 21, 22.)

[7] Neither the presumption of regularity in the Office proceedings nor the presumption of validity attending the issuance of a patent is conclusive, and such presumptions may be overcome by evidence showing that the claims are in fact without foundation in the original disclosure of the patent. Thus, in *Schriber Co.* v. *Cleveland Trust Co.*, 305 U. S. 47, 57, the Court, in discussing the effect of R. S. § 4888, said:

> "It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires, Permutit

For that purpose the defendant places sole reliance upon Figure 7 of the Hunt patent.

Thus, the Examiner, in his statement before the Board of Appeals said:

> "The embodiment relied upon for anticipation is that shown in Figure 7 of Hunt." (R. 244)

In its opinion, the Board of Appeals said:

> "It is alleged by appellant and admitted by the Examiner that the three claims in question concern Figure 7 only of the Hunt patent." (R. 260)

And again, on plaintiff's petition for review, the First Assistant Commissioner said:

> "It is contended that Figure 7 of the Hunt patent on which alone these claims read, does not disclose an operative device and that an amendment to the Hunt application, filed after petitioner's application was filed, constitutes new matter." (R. 284)

In his brief filed in the Court below on final hearing, the solicitor for defendant said:

> "Admittedly the claims in issue do not read on the devices of Figs. 1 to 6 of the Hunt drawings but only on the device shown in Fig. 7."

Co. v. Graver Corporation, supra, at 57: that *it cannot be enlarged by claims in the patent not supported by the description*. Snow v. Lake Shore & M. S. Ry. Co., 121 U. S. 617; cf. Smith v. Snow, 294 U. S. 1; and that *the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed*, at least when adverse rights of the public have intervened. Railway Co. v. Sayles, 97 U. S. 554, 563, 564; Powers-Kennedy Corp. v. Concrete Co., 282 U. S. 175, 185-186; cf. Webster Electric Co. v. Splitdorf Electrical Co., 264 U. S. 463; Permutit Co. v. Graver Corporation, supra; Crown Cork & Seal Co. v. Gutmann Co., 304 U. S. 159." (Italics supplied)

I-B.

Figure 7 of the Hunt patent is inoperative on its face.

A device constructed in accordance with the drawing of Figure 7 of the Hunt patent would be clearly inoperative, and it is so conceded by the defendant.

Thus, the Examiner in his statement before the Board of Appeals, said:

> "It is conceded that Fig. 7, if constructed as an accurate working drawing, does not disclose a workable device." (R. 244)

And in the brief filed on behalf of defendant upon final hearing in the court below, his solicitor stated:

> "The original drawing of Figure 7 admittedly is inaccurate."

The conclusions of law filed by the Court below likewise state:

> " * * * a device as specifically shown in Figure 7 of the Hunt patent would not be operative, * * * ." (R. 130)

I-C.

The inoperativeness of figure 7 of the Hunt patent may be cured, but any modification thereof made in conformity with the specification and teaching of the Hunt patent would not produce a device capable of performing the several functions called for by the specific limitations of the claims in issue. Any modification of the device of figure 7, which would enable it to satisfy the limitations of the claims in suit, would be antithetical to the specification, disclosure and teaching of the Hunt patent and would require invention.

Plaintiff recognizes, of course, that a patent drawing is not required to be an exact working drawing and that due allowance should be made for draftsman's errors. And plaintiff at all times has conceded that the manifest imperfection of the device as shown in Figure 7 of the Hunt patent might be cured. Indeed, plaintiff, at the trial, went so far as to show by the testimony of its expert witnesses how such inoperativeness of the device might be overcome.

It is believed, however, that the questions as to whether or not the drawing of Figure 7 is operative and as to the precise modifications which would be necessary to make it operative, are of secondary importance only in the present case.

It would seem to be self-evident that a patent should not be given a broader construction, merely by reason of the circumstance that the drawing, upon which the claims to the invention rest, is inoperative, than it would be entitled to receive if such drawing disclosed a device fully operative in exact accordance with the description, specification and teaching of the patent.

The fundamental question therefore, in plaintiff's view, is whether the claims in issue would be readable upon the device as shown in Figure 7 of the Hunt patent, assuming that that device is operative in precise accordance with the description, specification and teaching of the Hunt patent.

Accordingly, plaintiff throughout the proceedings, has taken the position that even if the device shown in Figure 7 of the Hunt patent were operative in exact accordance with the specification, disclosure and teaching of the Hunt patent, and even if such device had been disclosed in the Hunt application as originally filed, it still would not satisfy, either in structure, function or mode of operation, the specific limitations of the claims in issue.

In support of this position, plaintiff relies primarily upon the description of Figure 7 as set forth in the specification of the Hunt patent.

The Hunt invention relates generally to an automatic choke valve mechanism for use in connection with internal combustion engines (R. 302). In contradistinction to the Henning type of mechanism, which employs a strong thermostat to hold the choke valve in closed position during the cranking operation and a piston operated means or vacuum take-off to move the valve to a partially opened position against the force of the thermostat immediately upon the firing of the engine (R. 62, 64), the Hunt invention employs a relatively weak thermostat, itself incapable at any time of holding the choke valve in closed position, and a supplementary piston operated latch or toggle mechanism, the sole function of which is to hold the choke valve in closed position during the cranking operation. (R. 62, 63, 64)

This principle of the Hunt invention is set forth in the Hunt specification thus (R. 341):

> "Various automatic devices have been heretofore suggested for operating the valve with the idea of eliminating the manual control, but all of them, insofar as I am aware, *have made no provision for an increased force to hold the valve in its fully closed position.* Prior to the present invention, it has been customary in automatic control devices to close the valve by a spring which obviously exerts a decreased closing force as it nears its free position, and which free position corresponds to the closed position of the valve. *It is believed that the resistance to opening should be increased in the closed position of the valve and a mechanism accomplishing this function is an important feature of this invention.*" (Lines 9-23 inc.)

In conformity with the basic principle of the Hunt invention thus expressed, the Hunt patent discloses in Figures 1 to 5, Figure 6 and Figure 7 respectively, three forms or modifications of the Hunt invention.

With respect to the operation of Figures 1 to 5 inclusive of the Hunt patent, the specification states (R. 342):

> "In the operation of the invention with particular reference to the forms shown in Figures 1 to 5, inclusive, the initial start of the engines is ordinarily made with a cold thermostat and with the choke valve in the position shown in full lines in Figure 2. * * *
>
> "The vacuum developed by the cranking operation is insufficient to lift piston 40 against the resistance of spring 44 and valve 24 is substantially locked in its closed position by the pressure of pin 47 within the notch 48. As soon as the

> engine starts, the vacuum above the throttle is increased and piston 40 is moved upwardly and removes the pressure upon pin 47. Thereupon, valve 24 may be moved *by air flow* in a clockwise direction *against the tension of spring 67* until bracket 64 has the outer portion of its side face in contact with lever 62, which movement is preferably not over 10 or 15 degrees.[8] After the engine is started, the hot gases in exhaust pipe 53 transmit heat to the thermostat 54 which rotates cam 58 in a clockwise direction as viewed in Figure 3, and moves the end of lever 62 to the outer portion of slot 59. This movement of lever 62 rotates valve 24 in a clockwise position until the valve reaches the position shown in dotted lines in Figure 2." (Lines 83-111)

With reference to Figures 6 and 7, the specification states (R. 342):

> "In the operation of the forms shown in Figures 6 and 7, a similar result will be obtained, although in Figure 6, the resistance against initial opening is secured by a pin riding in a notch 74 formed on the periphery 76 of the circular portion of lever 31, *and in Figure 7, the resistance is obtained by the straight line position of the toggle.*" (Lines 125-132)

If, therefore, it be assumed that Figure 7 of the Hunt patent disclosed, as of the filing date of the Hunt application, a device of the precise character described in the Hunt specification and fully capable of performing the exact functions ascribed to it thereby, it would seem manifest that such device would nevertheless wholly fail to satisfy, either in structure, function or mode of operation, the specific limitations called for by the claims in issue. For such a device employs a weak thermostat which is itself incapable of moving the choke valve to fully closed position at any time. That function is performed by the action of spring 67, either aided or unaided by the inherent resiliency of the bellows 85. The thermostat does not and cannot therefore hold the choke valve in closed position during the cranking operation, but that function, in the device of Figure 7, is performed by the straight line position of the toggle lever 80, 82 and 83. Furthermore, at high temperatures the action of the cam 58, 60 upon the lever 62 resting on the periphery of the cam is such as to prevent any movement of the choke valve toward closed position, other than that permitted by the spring 67. Consequently, the temperature responsive means 54, in the device of Figure 7, is physically incapable of "yieldingly urging the valve toward closed position".

---

[8] With respect to the parts 64 and 67, the patent states (R. 342):

> "A bracket 64 is secured to the end of shaft 26 by any desired means, such as clamp screw 66, and has an abuting face adapted to contact with lever 62 and permit bracket 64 to have a slight tilting movement with respect to the lever. A spring 67 is spirally wound about shaft 26 and has its opposite ends coacting between lever 62 and bracket 64 in a manner to urge choke valve 24 toward its closed position, or in a counterclockwise direction as shown in Figure 2." (Lines 26-36)

Again, the toggle lever 80, 82 and 83 and bellows 85 in the device of Figure 7, does not satisfy that limitation of the claims in issue which requires "means responsive to suction posterior to the throttle for moving the valve to a partially opened position against the force of the temperature responsive means", in that the sole function attributed by the Hunt specification to that means is to provide resistance against initial opening of the valve and to remove that resistance as soon as the engine begins to run. Immediately thereafter the valve 24 is moved "by air flow in a clockwise direction against the tension of spring 67." The movement of the valve to partially opened position is thus accomplished not by the bellows 85 but by the direct action of the air intake suction passing by the valve against the closing force of the spring 67 and indeed, against the inherent resistance of the bellows 85.[9] [10]

Although the foregoing references to the Hunt specification as applied to the operation of the device shown in Figure 7, standing alone, are believed to be a conclusive refutation of the Hunt patent as an anticipation of the claims in issue, the same result is independently established, it is believed, by the testimony and documentary and physical Exhibits adduced by plaintiff at the trial.

Thus, the patentee, Hunt, testified:

> "In the job that was sold commercially, a toggle mechanism was used, as in figure 7" (R. 25).
>
> "The vacuum piston in the commercial job operated a cam which broke the toggle" (R. 26).
>
> "This device as shown cannot open the door Figure 2" (R. 30).
>
> "There is no device from figure 1 to figure 5 whereby the vacuum opens or tends to open the choke valve" (R. 30).

---

[9] This analysis of the operation of the device shown in Figure 7 based upon the description and specification thereof contained in the Hunt patent, was fully presented to the Court below, not only in oral argument and in the brief filed by plaintiff on final hearing, but again in the motion for additional findings filed by plaintiff on June 2, 1939. (R. 131-134)

[10] The tribunals of the Patent Office held that the claims in issue were satisfied by the device as shown in Figure 7 of the Hunt patent, upon the theory that the invention thereof was inherent in the operation of that device. In so holding, it is believed that those tribunals overlooked the clear description and teaching of the Hunt specification with respect to that device. The Court below made no reference in its opinion, findings or conclusions with respect to the operation of the device shown in Figure 7 in relation to the specification of the Hunt patent, and it is believed that the Court below thus overlooked and failed to pass upon plaintiff's basic contention in this case.

> "Q. No; I mean, is there any device or arrangement, or is the operation of opening the door described in the specification of the Hunt patent? A. I do not believe it is. You mean the descriptive matter as to how from 1 to 5 operate.
>
> "Q. Yes. A. *I do not believe that there is any place in there where it describes where the piston actually opens the door*" (R. 30).

Plaintiff introduced, as its Exhibit 6 a photostatic copy of Figures 6 and 7 of the original Hunt drawings (R. 88). In respect thereto the witness Hunt testified:

> "The structure shown in figure 7 of Exhibit 6 is a toggle mechanism substituted for a groove and pin to add friction or strain on the choke valve to prevent it from opening when the choke valve is in the closed position" (R. 32).
>
> "Q. How long did you use this particular device, Mr. Hunt? A. This device as exactly shown was never used commercially. We substituted a vacuum piston for the device. The bellows was never used" (R. 33).
>
> "Q. At about the time you filed your application, did you build any models or devices corresponding generally to the device shown in figure 7? A. Yes, sir" (R. 34).

The witness thereupon identified a chart which was introduced in evidence as plaintiff's Exhibit 7, (R. 89) and with respect thereto stated:

> "That is a device with the toggle mechanism and a vacuum device for unlocking the toggle mechanism; a thermostat for closing the choke valve, and putting the toggle mechanism in the locked position (R. 34).
>
> "The vacuum device on this particular model is a device for unlocking the toggle mechanism (R. 34).

> "On the shaft 'S' was mounted the choke valve and the lever that formed part of the toggle mechanism (R. 35).
>
> "The function of offsetting the valve is so that the valve would have the tendency to open as the velocity of air passing the valve increases (R. 36).
>
> "The function of this mechanism (S, 80, 82, 83) is to put a tension upon a choke valve for cold starting, and some way of breaking that tension by vacuum as the motor is started (R. 37).
>
> "If we did not have this mechanism and the thermostat was hooked up direct to the choke valve, if the tension of the thermostat was made strong enough to hold the choke valve so as to give an initial start, it would be too much tension for the initial run. If you lightened up the thermostat tension so that it was light enough to give you the initial run, it would not be strong enough tension to give you the initial start (R. 37).
>
> "In the device as shown in Exhibit 7, the vacuum piston is breaking the joint. It is not trying to close the choke valve by the spring that is under the vacuum piston. There is no tendency of the vacuum piston to close the choke valve, while *in the device, figure 7, there is a tendency of this device trying to close the choke valve*" (R. 38).

The chart of a second experimental device made by Hunt "in the spring of 1931" (R. 39) was introduced in evidence as plaintiff's Exhibit 8 (R. 90), and in respect thereto the witness Hunt testified:

> "Q. Do those members which you marked 'S' and '80', '82' and '83' represent parts of the mechanism corresponding to figure 7? A. Yes, sir.
>
> "Q. If the choke valve would not open by the direct action of suction, would the toggle mechanism for locking it have any function? A. No, because your valve would already be shut, and

> *that is all that the toggle mechanism can do—is to keep it shut"* (R. 40)
>
> "Q. Then do we understand that the function of the toggle mechanism is to lock it closed at a time when it would otherwise open and you did not want it to? A. Yes, that is true" (R. 42).

To assist the Court in an understanding of the devices illustrated in plaintiff's Exhibits 7 and 8, the witness Hunt identified certain drawings thereof, which were introduced in evidence as plaintiff's Exhibit 9 (R. 91).

The witness likewise identified, as drawings of the Hunt commercial device, plaintiff's Exhibits 10, 11 and 12 (R. 92, 93, 94). The model of the carburetor illustrated in plaintiff's Exhibit 11 was also identified by the witness and introduced in evidence as plaintiff's Exhibit 13.

Regarding the Hunt commercial device, the witness Hunt testified:

> "Q. So that in all of these devices, including their commercial device, the straight line toggle mechanism is used to latch the choke valve in closed position? A. That is true."
>
> "Q. And then, when the manifold vacuum is built up as you have described, that breaks the straight line position of the toggle; is that correct? A. That is correct" (R. 48).
>
> "Q. Now in all of these (charts) it appears from the figure that the cam is on what you might call the back side of the toggle; is that correct? A. That is correct."
>
> "Q. The toggle moves away from the cam when it opens? A. Yes, sir."
>
> "Q. Is that true in the commercial device? A. Yes, sir."
>
> "Q. Is it true in these earlier models? A. Yes, sir."

It thus appears from the express testimony of the patentee, Hunt, himself that in all the embodiments of the invention of the Hunt patent made by him, both in the development thereof and in the device commercialized by his assignee, Bendix Products Corporation, the automatic choke mechanism employed was a combination of a weak thermostat and toggle mechanism, actuated either by a vacuum piston or bellows to hold the choke valve in closed position during the cranking operation; that in all of those embodiments the sole function of the suction operated means was to break the toggle; and that in none of such embodiments was the toggle and vacuum piston or bellows mechanism so constructed as to be able to assist in any way the opening of the choke valve, much less to move the choke valve toward a partially opened position against the force of the thermostat.

It therefore appears that Hunt himself did not at any time either conceive or reduce to practice in an operative device the invention covered by the claims in issue.

The witness Markham identified Plaintiff's Exhibits Nos. 15 and 16[11] as two embodiments of Hunt Figure 7 which represented the result of his experiments in an attempt to overcome the inoperativeness of the device as shown in Figure 7.

With respect to Exhibit 15, Markham testified:

> "Q. Have you ever tried to build a device according to figure 7 or representing that figure? A. I have built a model as close to that figure as I possibly could—scaling and making it in proportion throughout.

---

[11] These exhibits will be handed to the Court at the time of the argument.

> "Q. Would it function at all, in any satisfactory way? A. That particular model, built to those proportions, would not, of course, because there was nowhere near sufficient movement in the Sylphon to permit the travel required to open the choke valve to any great extent (R. 54).
>
> "In order to obtain sufficient travel, and not having a Sylphon of sufficient length available, I merely slotted this bracket (on which the Sylphon is mounted on the model) so that I could move it up or even take the screws out. That of course would give sufficient vertical motion to this link. (Marked by the witness 90 on Figure 7 of plaintiff's Exhibit 5) (R. 55).
>
> "Q. In that device, as you are now demonstrating it, is that a satisfactory control for an automatic choke? A. In my opinion it is not" (R. 55).

With respect to plaintiff's Exhibit 16, the witness testified:

> "The change that was made: The vertical lever, which I marked '90', was substituted by two pieces, which were pivoted together, forming another joint between the central toggle pivot and the attachment at the lower end of the Sylphon (R. 56).
>
> "Q. What was the function of the Sylphon? A. *The function of the Sylphon is merely to break the toggle* (R. 57).
>
> "It seems in the two links which connect the central pivot of the toggle, that the lower part of the Sylphon was in a straight line. It is conceivable that the Sylphon, which collapses, will open the choke; but after the toggle is broken, the amount of air, or any substantial amount of air passing the choke valve will break this straight line, after which the Sylphon cannot pull the choke open" (R. 57).

Again, on redirect examination the witness testified:

> "Q. Now, in figure 7, if the Sylphon only opens the choke valve partially, can the choke valve ever open fully? A. No, not with that hook-up.
>
> "Q. Is not that the real difficulty with it? A. Yes, sir, it is.
>
> "Q. And when you put in the flexible link on Exhibit 16 you got away from that to a certain extent, did you not? A. The insertion of the two links now permits the valve to open, but when that is done the Sylphon does not open the valve.
>
> "Q. *The valve opens by the direct action of the suction? A. That is right.*
>
> "Q. Yes. Now, even on this first exhibit, No. 15, you said that you knew that this linkage would not open, but you put some slots in there that would give you a lot of travel to help it to open, is that right? A. That is right" (R. 60).

The testimony of the witness Boyce fully corroborates that of Hunt and Markham. Thus, Boyce testified:

> "Q. How many general types of automatic chokes are in general use? A. Two.
>
> "Q. Please state what those types are. A. There is one type that employs a relatively strong thermostatic element. It closes the choke valve and holds it closed against the suction during the cranking operation. There is another that uses a relatively weak thermostatic element, and is held closed during the cranking operation by a latching device or a latching means (R. 61-62).
>
> "Q. I will ask you about the Bendix-Stromberg type. What type is that? A. That is of the relatively weak thermostatic element, using a latching device to prevent the valve opening during the cranking operation.
>
> "Q. And what is manufactured by Carter? A. The relatively strong thermostatic element that

holds the valve in a closed position without latching.

"Q. And how can they manage to get by with such a strong thermostat? A. Well, in the Carter type of automatic choke they use what is commonly termed the vacuum take-off. In other words, a pistor arrangement to act as soon as the motor begins to fire, to open the choke against the tension of the thermostat.

"Q. In the latch type that has the weak thermostat, does the intake manifold vacuum-operated device hold the choke open against the force of the temperature-responsive means? A. By acting on the valve. *The latching device does not open the choke.*

"Q. But the suction direct on the valve opens it? A. *The suction on the unbalanced or off-center valve causes the valve to open* (R. 62-63).

"Q. And which type of choke is shown in the Hunt patent, No. 1,945,191? A. Of the relatively light thermostatic element which requires a latch to hold the valve in the closed position during the cranking period (R. 64).

"Q. What is shown on figure 7? A. It is shown as a locking device, a toggle in a straight line, in a relative straightline position, which prevents the choke opening.

"Q. Which class of choke is that? A. That would be of the weak thermostatic element type" (R. 65).

With respect to plaintiff's Exhibit 16, the witness testified:

"Q. This Sylphon has been moved up considerably, has it not? A. As a matter of fact, it has been moved up about probably a half inch.

"Q. What is that for? To get it out of the way? A. To get it out of the way so that the choke can open without being loaded by the spring tension of the Sylphon.

> "Q. Is that undesirable—if the choke is loaded by the spring tension of the Sylphon? A. The only load that is wanted on the choke valve is the load imposed by the thermostatic element while it is cool. Any additional load would be undesirable" (R. 65).

The witness Coffey likewise testified to the same effect:

> "Q. Then what is your considered opinion as to the utility and operativeness of figure 7 of the Hunt patent? A. I do not think that anyone could ever build it and make it operate (R. 78-79).
>
> "Q. In figure 7 the Sylphon breaks the toggle, and in Exhibit 8 the Sylphon breaks the toggle; is that right? A. That is right (R. 79).
>
> "Q. But in Exhibit 8 the Sylphon is connected to the toggle by a flexible linkage, and the Sylphon itself is mounted out of the way of the travel of the linkage; is that correct? A. That is right. This valve is free after the linkage is broken to be opened wide or closed without moving the Sylphon.
>
> "Q. Do you mean that the valve is trying to open freely against the thermostat, and that the Sylphon is only in the way? Is that correct? A. *The Sylphon is not in the way in Exhibit 8, but it is in figure 7* (R. 80).
>
> "Q. Just a moment. If you were going to modify figure 7, and had to use some of the structure that you see there, and make an operative carburetor, what would be the simplest thing you could do to make it work? Could you shift it over to what you see in Exhibit 8? A. That would be one of the first things I would do; it would be to put this broken link in there to get away from that bellows.
>
> "Q. And is that open link what we have in Exhibit 16 here? A. That is like that.

* * * * * *

> "Q. And does the device in Exhibit 8 have any suction-operated means to pull the choke valve open against the force of the heat-temperature-responsive means? A. No, it does not. *All it can do is break the toggle*" (R. 80).

In the light of the specification of the Hunt patent and of the unchallenged and unopposed testimony of plaintiff's witnesses, including the patentee Hunt, it is believed manifest that Figure 7 was never intended to be, and cannot, by any modification consistent with the specification of the Hunt patent, be made operative, as an embodiment or disclosure of the invention characterized by the claims in issue.

Plaintiff's Exhibits 7, 8, 10, 11 and 16 represent various modifications of the device as shown in Figure 7. All of these were operative. Indeed, that illustrated in Exhibits 10 and 11 represents the device which was developed by The Bendix Products Corporation for commercial use. Yet, in none of these devices was the structure such as to permit or enable "means responsive to suction posterior to the throttle" to move the "valve to a partially opened position against the force of the temperature responsive means."

No one in this case has shown or even attempted to show any practical modification of the device of Figure 7 which would enable it to perform the particular functions of the claims in issue. The reason therefor is obvious. Any modification of the device of Figure 7, which would enable it to satisfy the limitations of the claims in suit, would be antithetical to the specification, disclosure and teaching of the Hunt patent and would itself require invention.

I-D.

Claims 36, 37 and 38 of the Hunt patent which were inserted therein by amendment of February 10, 1933, constituted new matter in the Hunt application, and such claims are invalid in view of the prior disclosure on November 17, 1931, in the Henning application, of the invention covered by those claims.

It follows that Claims 36, 37 and 38 of the Hunt patent were wholly without support in the specification or drawings of the Hunt application, and, consequently, that those claims constituted new matter in the Hunt application, at the time when they were introduced therein by amendment of February 10, 1933. Such claims cannot therefore validly anticipate the claims in issue which were fully disclosed in the Henning application nearly 15 months prior thereto. *Schriber Co.* v. *Cleveland Trust Co.,* 305 U. S. 47, 57.

To paraphrase the language of the Supreme Court in *Stelos Co.* v. *Hosiery Corp.,* 295 U. S. 237, 241: "Defendant is upon the horns of a dilemma; Hunt either discovered the invention of Claims 36, 37 and 38 prior to the application for his patent or he found it later. If the first supposition be correct, his application violated R. S. §4888; if the second, his patent does not cover that invention."

CONCLUSION.

Henning is the first inventor of the invention covered by Claims 20, 21, 22, 25 and 26 in issue, and is entitled to a patent therefor. The decree of the District Court should therefore be reversed, with directions to enter a decree in conformity with the prayers of the bill of complaint.

Respectfully submitted,

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Dated: November 27, 1939.

UNITED STATES
COURT OF APPEALS FO
DISTRICT OF COLU

FILED JAN 30 1940

Joseph W. Stewart

No. 7476

In the United States Court of Appeals for the District of Columbia

Edward S. Levine
~~CARTER CARBURETOR CORPORATION~~, APPELLANT

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS

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CARTER CARBURETOR CORPORATION, APPELLANT

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CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE DISTRICT OF COLUMBIA.

BRIEF FOR THE COMMISSIONER OF PATENTS

This is an appeal from the judgment of the District Court of the United States for the District of Columbia in an action brought by appellant under Section 4915 R. S. (U. S. C., title 35, rec. 63), to authorize the Commissioner of Patents to issue appellant a patent on application of Otto Henning No. 575,577 for improvements in "Internal Combustion Engines."

A number of claims have previously been allowed appellant, but of the claims here in contest claims 20, 21, and 22 were copied from the patent to Hunt No. 1,945,191 where they appear as claims 36, 37, and 38, and claims 25 and 26 although not contained in the Hunt patent are similar to the Hunt claims 36, 37, and 38, and appellant concedes that the disposition of claims 20, 21, and 22 are determinative of his right as to claims 25 and 26 (R. 14 and 15).

Appellant has copied claims 20, 21, and 22 in his brief at pages 3 and 4 and it is to be noted that one error appears in line 6 of claim 21 wherein the phrase "said suction means" should be "*and* suction means."

This same error appears in the copy of the claim at page 10 of the record, but at page 191 of the record the claim appears in its proper wording.

APPELLANT'S DEVICE

Appellant's application relates to an automatic choke valve mechanism in combination with a carburetor for internal-combustion engines. The specific structure and operation of appellant's device has been accurately described at page 5 of appellant's brief and repetition here is needless.

THE HUNT PATENT

The patent to Hunt No. 1,945,191 (R. 339) discloses a device similar in many respects to that of appellant. In the form shown in Fig. 7, which is the only form which is relied on for anticipation, the choke valve is illustrated at 24. The opening of the choke valve is controlled by the cam 60, thermostatic element 54, and in addition by the sylphon bellows 85 working through the linkage 80, 81. When the engine is started suction is produced in the sylphon bellows 85 causing it to contract, raising the pin 82 and right-hand end of link 80. The raising of the link 80 causes a rotation of the link 81 which in turn rotates the shaft 26 and the choke valve 24, causing the choke valve to open partially. This rotation also causes the link 62 to move angularly, rotating the cam 60 by means of its connection in the slot 59 thus placing tension on the thermostat 54 which, through the linkage just mentioned, resists the opening of the choke valve 24.

SUMMARY OF ARGUMENT

1. The Hunt patent although copending with appellant's application is nevertheless available as a reference.

2. Fig. 7 of the Hunt patent is inherently operative and modifications of the exact scale showing thereof may be made by anyone skilled in the art to produce an entirely operative device performing its functions in accordance with the terms of the claims in issue.

3. The insertion of claims 36, 37, 38, and the addition of a showing of a thermostat in Fig. 7 of the Hunt patent did not constitute new matter but was merely a more definite illustration of matter originally disclosed.

ARGUMENT

Claims on Appeal

Claims 20, 21, 22, 25, and 26 are to be found in the record on pages 10 and 11.

AVAILABILITY OF THE HUNT PATENT AS A REFERENCE

Appellant copied claims 20, 21, and 22 in issue herein from the Hunt patent and asked for an interference therewith. Appellant did not, however, allege any date of invention prior to the filing date of the Hunt patent at the time of making the claims therefrom as required by rule 94 of the Rules of Practice in the United States Patent Office which states in part:

> Interference will be declared between * * * applications for patents * * * and unexpired original or reissued patents * * * when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided,* That where the filing date of any application is subsequent to the filing date of any patentee, the applicant shall file affidavit that he made the invention in controversy before the filing date of the patentee.

In the present instance the filing date of the Hunt patent antedates the filing date of appellant's application by six months, yet appellant failed to make any averment that he made the invention in controversy before the filing date of the Hunt patent as required by the rule.

Having failed to make this averment or to submit any proof of his earlier inventorship it appears clear that appellant did not make the invention prior to the filing date of the Hunt patent and the Hunt patent is a reference as of its filing date under the doctrine enunciated by Mr. Justice Holmes in the case of *Alexander Milburn Company* v. *Davis-Bournville Company,* 270 U. S. 390. Indeed appellant makes no contention that on the basis of filing date alone Hunt is not a valid reference but rather contends that the device illustrated in the Hunt patent at Fig. 7 is inoperative, if made operative does not satisfy the terms of the claims in issue and further that the disclosure in the Hunt patent relative to Fig. 7 and Hunt's claims 36, 37 and 38 corresponding to claims 20, 21 and 22 in suit involve new matter introduced after the Hunt application was filed.

OPERATIVENESS OF HUNT DISCLOSURE

It is admitted and was so admitted at trial (R. 20) that if the patent drawing of the Hunt Fig. 7 were taken as a working drawing. the device is inoperative. This arises from the fact that the links 80 and 81 in the drawing are not properly proportioned and the link 80 in its full line position is shown longer than the link 80 in its dotted line position.

Much of the testimony introduced by appellant related to this so called inoperativeness and in the alleged attempts of the appellant's witnesses to make the device of Hunt's Fig. 7 operative. This testimony. however. merely indicates, as evidenced by the testimony recorded at pages 54. 59 and 60 of the record. that a device made exactly to the scale of the patent drawings would not operate. This was obvious before any model was built. When a more flexible sylphon was used. however. the movement of the arm did cause the choke valve to partially open as recited in the claims in issue (R. 59).

Several methods of making the device of Hunt's Fig. 7 have been suggested. the appellant and his witnesses going to such extremes as to provide double links and other changes which, while making the device operative. so changes its operation that it does not meet the terms of the claims (R. 56).

It is submitted, however, that no such elaborate redesign of the Hunt mechanism is necessary. all that is required is a change in proportions so that the link 81 is made short to cause a greater angular movement of the choke valve 24 and a longer flexible sylphon 85 to give a greater degree of movement. When these simple changes are made the device is quite operative and fully satisfies the terms of the claims.

Patent drawings are never intended as scale drawings, and the mere fact that a device built exactly to the scale of the patent drawings of Hunt (R. 54) would not operate is not evidence that the Hunt device is inherently inoperative. *Manhattan Book Casing Machine Co.* v. *E. C. Fuller Co.*, 204 F. 286.

Appellants have also attempted to show that the Hunt device of Fig. 7 could not be made into a practical commercial device and still perform the functions of the claims in issue.

It is not necessary, however, for a device of a patent to be a commercial success in order that it be a valid reference. In the case of *Hildreth* v. *Mastoras*, 257 U. S. 27, Mr. Chief Justice Taft, in speaking of the question of operativeness in the patentable sense, said:

> It is not necessary, in order to sustain a generic patent, to show that the device is a commercial success. The machine patented may be imperfect in its operation, but if it embodies the generic principle and works, that is, if it actually and mechanically performs, though only in a crude way, the important function by which it makes the substantial charge claimed for it in the art, it is enough.

Likewise in *Williams* v. *Handschiegl*, 18 C. C. P. A. 1176; 48 F. (2d) 395, the court said in part:

> Proof that it is imperfect in operation, that it performs its functions in a crude way, or that it does not meet commercial requirements, is not sufficient to establish inoperativeness in a patentable sense.

While the Hunt patent insofar as Fig. 7 is concerned at least may be a mere paper patent, not capable of successful practical operation, this does not defeat its relevancy as a limitation upon the application in suit. *Westinghouse Air Brake Co.* v. *Christensen Engineering Co.*, 128 F. 437.

NO NEW MATTER IN HUNT APPLICATION

The original Hunt disclosure of Fig. 7 is as shown in the record at page 314. No thermostatic element was shown, but the statement appeared in the specification that the thermostatic element was the same as described in connection with Fig. 6.

Later the drawing was changed to include the thermostat and the reference in the specification to the thermostat of Fig. 6 was changed to refer to the thermostat of Fig. 3.

Nothing improper appears in the change of the words "Figure 6" to "Fgure 3." The thermostat is not shown in such great detail in Fig. 6 as it is in Fig. 3 and while from a reading of the Hunt specification it seems clear that the same thermostat is intended to be used in both figures, a reference to Fig. 3 would seem to be the more appropriate since this figure includes the greatest detailed showing.

Regardless of the controversy relative to the showing of the thermostat, it seems clear that the original Fig. 7 of Hunt (R. 314) discloses the operation of choke valve opening as recited in the claims in issue. The sylphon 85 is shown as breaking the toggle and rotating lever 81 which must of necessity rotate the choke valve to a partially open position as recited in the claims.

It is true that the primary purpose of the sylphon is to break the toggle and thus unlatch, as it were, the choke valve; but the very fact of this action both in the Hunt Fig. 7 as originally disclosed and the mechanism as disclosed in Fig. 7 of the Hunt patent, causes the choke valve to open partially, which is all that is recited in the claims in controversy.

It is interesting to note that Hunt himself was called as a witness for appellant and while he was in no wise hostile to appellant (R. 26) he did not testify that the device as shown in Fig. 7 was inoperative or that it was not shown after the amendment in question exactly as he intended it to be originally shown.

As a matter of fact although Hunt testified that the Sylphon was primarily intended as an unlocking device, he stated that it would also open the choke slightly (R. 34).

The appellant's own testimony, therefore, appears to disprove rather than tend to support the contention that the Hunt device is inoperative and that new matter was inserted by the amendment which introduced claims 36, 37 and 38 corresponding to claims 20, 21 and 22 herein.

CONCLUSION

In conclusion it is submitted that none of the claims on appeal recite anything involving invention over the disclosure of the Hunt patent as originally filed; that the disclosure of the Hunt patent is operative and does not involve the introduction of new matter and that the ruling of the lower court should therefore be affirmed.

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